

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#5
5-1-02
11046 U.S. PTO
09/976437
10/15/01

In re Patent Application of

Heroux et al

Atty. Ref.: 2528-8

Divisional of Serial No. 09/157,808

Group:

Filed: October 15, 2001

Examiner:

For: ASSAYS FOR MEASURING NUCLEIC ACID BINDING
PROTEINS AND ENZYME ACTIVITIES

* * * * *

October 15, 2001

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

INFORMATION DISCLOSURE STATEMENT

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. Copies of the documents listed in bold type on the attached PTO-1449 Form are attached. Copies of documents which are of record in the parent application are not attached.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith. It is further understood that the Examiner will consider information that had been cited by or submitted to the U.S. Patent and Trademark Office in a prior application relied on under 35 U.S.C. § 120. 1138 OG 37, 38 (May 19, 1992).

Applicants have checked the appropriate boxes below.

1. ☒ This Information Disclosure Statement is being filed within three months of the U.S. filing date OR before the mailing date of a first Office Action on the merits. No statement under 37 C.F.R. § 1.97(e) or fee is required. In the event, a first Office Action has been mailed prior to filing of the present Information Disclosure Statement, the Office is requested to treat the present paper s a submission under 37 C.F.R. § 1.97(c) and charge the undersigned's Deposit Account No. 14-1140 for the fee required by 37 C.F.R. § 1.17(p). The present paper is submitted in duplicate for this purpose.

2. ☐ This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection or Notice of Allowance.

- a. ☐ I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- b. ☐ I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

- c. ☐ Attached is our Check No. in the amount of \$ in payment of the fee under 37 C.F.R. § 1.17(p).
3. ☐ This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. It is hereby requested that the Information Disclosure Statement be considered. Attached is our Check No. in the amount of \$ in payment of the fee under 37 C.F.R. § 1.17(i).
- a. ☐ I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- b. ☐ I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
4. ☐ Relevance of the non-English language document(s) is discussed in the present specification.
5. ☐ The document(s) was/were cited in a corresponding foreign application. An English language version of the foreign search report is attached for the Examiner's information.
6. ☐ A concise explanation of the relevance of the non-English language document(s) appears below:
7. ☐ The Examiner's attention is directed to co-pending U.S. Patent Application No. , filed , (copy attached) which is directed to related technical subject matter. The identification of this U.S. Patent Application is not to be construed as a waiver of secrecy as to that application now or upon issuance of the present application as a patent. The

Heroux et al
Serial No. 09/157,808

Examiner is respectfully requested to consider the cited application and the art cited therein during examination.

8. ☐ Copies of the documents were cited by or submitted to the Office in Application No. , filed , which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and to indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 14-1140 referencing docket number 2528-8.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

B. J. Sadoff
Reg. No. 36,663

BJS:eaw
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

INFORMATION DISCLOSURE
CITATION

ATTY. DOCKET NO.

DIVISIONAL OF SERIAL NO.

2528-8

09/157,808

APPLICANT

Heroux et al

FILING DATE

GROUP

(Use several sheets if necessary)

October 15, 2001



U.S. PATENT DOCUMENTS

*EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	5,453,356	9/1995	Bard et al			
	5,866,434	2/1999	Massey et al			
	6,174,709 B1	1/2001	Kenten et al			
	6,048,687	4/2000	Kenten et al			
	5,620,850	4/1997	Bamdad et al			
	6,207,369 B1	3/2001	Wohlstadter et al			
	5,779,976	7/1998	Leland et al			
	5,597,910	1/1997	Gudibande et al			
	5,635,347	6/1997	Link et al			
	5,714,089	2/1998	Bard et al			
	5,157,032	10/1992	Barton			
	5,610,017	3/1997	Gudibande et al			

FOREIGN PATENT DOCUMENTS

DOCUMENT	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
WO 87/06706	11/1987	PCT			
WO 98/12539	3/1998	PCT			
WO 97/33176	9/1997	PCT			
0 658 564 A1	6/1995	European Patent Application			

OTHER DOCUMENTS (including Author, Title, Date, Pertinent pages, etc.)

	Garner, Mark M., et al, <i>Nucleic Acids Research</i> , Vol. 9, No. 13, pp. 3047-3060, 1981 "A gel electrophoresis method for quantifying the binding of proteins to specific DNA regions: application to components of the Escherichia coli lactose operon regulatory system"
	Galas, David J, et al, <i>Nucleic Acids Research</i> , Vol. 5, No. 9, pp. 3157-3170, September 1978, "DNAase footprinting: a simple method for the detection of protein-DNA binding specificity"
	Wilkinson, K.F. et al, <i>Pharmaceutical Research</i> , Vol. 10 No. 4, pps. 562-566 (1993), "Development of Activity Assays for High-Volume Evaluation ..."
	Kenrick, M.K., <i>Nucleic Acids Research</i> , Vol. 25, No. 14, pp. 2947-2948 (1997), "A homogeneous method to quantify mRNA ..."
	Heroux et al, <i>PCR Methods and Applications</i> , Vol. 4, No. 6, pps. 327-330, 1995, "Quantitative Analysis of Specific mRNA ..."
	Yacoub, A. et al, <i>The EMBO Journal</i> , 196, Vol. 15, No. 9, pages 2306-2312, "A drosophila ribosomal protein contains ..."
	Skerra Phosphorothioate primers improve the amplification of DNA sequences by DNA polymerases with proofreading activity. <i>Nucleic Acids Res.</i> Vol. 20, pages 3351-3554 (1992).
	Brenowitz et al, Dnase I footprint analysis of protein-DNA binding. In <i>Current Protocols in Molecular Biology</i> (Ausubel et al. Eds.) pages 12.4.1-12.4.16 John Wiley & Sons, New York (1989)
	DiCesare et al, A high-sensitivity electrochemiluminescence-based detection system for automated PCR product quantitation <i>Biotechniques</i> Vol. 15, pages 152-157, 1992.

*Examiner

Date Considered

Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to application.